REMARKS

Applicants have received and reviewed an Office Action dated September 9, 2003. By way of response, Applicants have canceled claim 5 without prejudice, amended claims 35-44, and added new claims 45 and 46. No new matter is presented. Claims 1-4, 6-9, and 31, 32, and 35-46 are pending. Applicants submit that the pending claims are supported by the specification.

Claims 35-44 were amended to correct an inadvertent typographical error. Newly presented claims 45 and 46 relate to particular use compositions and include subject matter previously indicated to be allowable.

For the reasons given below, Applicants submit the amended and newly presented claims are in condition for allowance and notification to that effect is earnestly solicited.

Petition for Extension of Time

It is noted that a two-month petition for extension of time is necessary to provide for the timeliness of the response. A request for such an extension is made extending the time for response from December 9, 2003 to February 9, 2004.

Claims 5 and 31

The Office Action asserts that claims 5 and 31 are essentially duplicates. Without acquiescing to this assertion, Applicants have canceled claim 5.

Rejection of Claims Under § 103(a)

The Examiner rejected claims 1-3, 5-9, 31, and 35-44 under 35 U.S.C. § 103(a) as obvious over Hei et al. (WO 99/51095) in view of Lokkesmoe et al. (WO 94/21122), FSTA abstracts 1999(10):C1223 and 2000(06):J1220 and Taylor. Applicants respectfully traverse this rejection.

Applicants maintain the arguments presented in the previous Amendment and Response against the prior art rejection. Applicants also wish to bring to the Examiner's attention evidence that the primary reference employed in the prior art rejection cannot be used in a prior art rejection. Further, Applicants wish to bring to the Examiner's attention

additional evidence that the presently claimed compositions exhibit unexpected results compared to compositions described in the references employed in the prior art rejection.

The Hei et al. Reference Cannot be Employed as Prior Art Against Claims in this Application

The Examiner had employed the Hei et al. (WO 99/51095) reference in a prior art rejection in this application. This reference is dated October 14, 1999. The present application was filed July 12, 2000. The Hei et al. reference is dated less than one year before the filing date of the present application.

The Hei et al. reference does not qualify as prior art under 35 U.S.C. § 102(a). Applicants submit herewith a Declaration Under 37 C.F.R. § 1.131 by an inventor, John D. Hilgren, establishing that the presently claimed invention was invented before the October 14,1999 date of the Hei et al. reference. Thus, this reference cannot be employed as prior art under § 102(a).

Further, the Hei et al. reference does not qualify as prior art under 35 U.S.C. § 102(e). A reference that is prior art only under § 102(e) cannot be used, according to § 103(c), in an obviousness rejection if the subject matter of the cited reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. A clear statement of entitlement to the prior art exclusion by Applicants or a registered practitioner is sufficient evidence to establish the prior art exclusion (Examination Guidelines for 35 U.S.C. § 102(e) (as amended and revised) at IV(5); 1266 TMOG 80, January 14, 2003).

Applicants hereby make a clear statement of entitlement to exclude the Hei et al. reference as prior art as provided by § 103(c). The Hei et al. patent is assigned to the assignee of the present patent application. The Hei et al. patent and the present patent application were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Therefore, the Hei et al. reference cannot be employed as prior art against claims in the present application. Thus, the prior art rejection made in the previous office action cannot be maintained.

The Presently Claimed Compositions Exhibit Unexpected Results

In the previous Amendment and Response, Applicants presented information and arguments establishing that the presently claimed compositions exhibit unexpected results compared to compositions disclosed in the prior art references cited in the rejection of the claims. Applicants submit herewith a Declaration Under 37 C.F.R. § 1.132 by an inventor, John D. Hilgren, providing additional evidence that the presently claimed compositions exhibit unexpected results.

The references cited in the rejection do not disclose or suggest the claimed narrowly tailored ranges and ratios of ingredients. Further, the references cited in the rejection do not disclose or suggest the unexpected result of greater killing at higher ratios of peroxyoctanoic acid to peroxyacetic acid. The references cited in the rejection do not disclose or suggest the compositions or the claimed unexpected effect. Therefore, the cited references neither teach nor suggest the presently claimed invention.

Accordingly, based on the foregoing differences, it is submitted that the references cited in the prior art rejection neither teach nor suggest the presently claimed compositions, and withdrawal of this rejection is respectfully requested.

Summary

In summary, Applicants submit that each of claims 1-4, 6-9, 31, 32, and 35-46 are in condition for allowance. The Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below, if the Examiner believes that doing so will expedite prosecution of this application.

Respectfully submitted,

Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903
612/332-5300

Dated: Feb 9, 2004

By: Mark T. Skoog
Mark T. Skoog
Reg. No. 40,178

23552
PATENT TRADEMARK OFFICE